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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/222,336	12/28/1998	GUY A. STORY JR.	02541.P009	3308
8791	7590	05/18/2004	EXAMINER	
BLAKELY SOKOLOFF TAYLOR & ZAFMAN 12400 WILSHIRE BOULEVARD, SEVENTH FLOOR LOS ANGELES, CA 90025			RETTA, YEHDEGA	
			ART UNIT	PAPER NUMBER

3622

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/222,336

Applicant(s)

STORY ET AL.

Examiner

Yehdega Retta

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nk

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 23. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This office action is response to the Amendment filed February 27, 2004.

Response to Arguments

Applicant's arguments filed February 27, 2004 have been fully considered but they are not persuasive.

Applicant's amendment to claim 24 overcomes the rejection of 35 USC § 101.

Regarding claims 1, 11, 21 and 24, applicant argues that Katz does not disclose a license with a cardinality that is generated by a license management device where information is provided to a content provider and the license is transmitted to a number of playback devices. The prior art, Katz teaches a license management device (Server 260) generating a license with cardinality (Group ID) and the license transmitted to playback devices, wherein the number of playback devices are less or equal to the cardinality (number of playback devices storing the Group ID) (see fig. 2& 10, col. 8 lines 30-63 and col. 12 lines 39-67). Applicant in his argument states that Katz teaches Group ID, but not a cardinality associated with a license or Group. Applicant broadly claims creating and transmitting a license having a first cardinality, the cardinality indicating the number of playback devices that can be authorized for playback however does not clearly state what kind of data is considered "license" which indicates the number of playback devices. According to applicant's specification, see page 12, the license is comprised of 32 bit group ID, or other identifier size. Further it is disclosed that each playback device storing a license belongs to a set of one or more playback devices storing the license, and the set being authorized to play the content.

Applicant is arguing that the Group ID of Katz is not the same as the cardinality associated with a license. Since applicant is broadly claiming “a license having a first cardinality, wherein the cardinality indicates the number of playback devices that can be authorized for playback of associated digital content, and does not state what information is considered a “license”, therefore, in light of applicant’s specification and as broadly interpreted, the examiner consider the group ID as a license having a cardinality, since the group ID, perfumes the same functionality, i.e., indicates the number of playback devices that are authorized to playback the content. If the cardinality is different than the Group ID as argued by applicant, then applicant should clearly claim what kind of data, is created that patentable distinguish the claim from the prior art, since the functionality of the group ID is the same as the “license” since both are used authorize playback devices to playback the digital content.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The independent claims 1, 11 and 21 recites a “transmitting via a first network connection, information corresponding to the first license to content provider from the license

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management device” and transmitting via a second network connection, the first license to a first set of playback devices ...”. Applicant’s specification discloses the license management device communication with content providers to manage licenses. It also discloses that the license being communicated to the content provider. The specification discloses, in one embodiment the provider embedding the license in the digital content and alternatively the license management device issuing a command that causes the license to be embedded in the digital content. The specification, further discloses, “alternatively the license management device can communicate the creation of a license to an appropriate content provider that, in turn, includes the license in digital content”. The specification however, does not disclose or suggest, that the license management device transmitting information corresponding to the license to the provider via a first network connection and license to the playback devices via a second network connection. Therefore, the specification does not disclose the claimed subject matter in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 3, 13 and 23 also recite “ transmitting via a third network connection information corresponding to the second license to the content provider from the license management device” and transmitting via a fourth network connection, the second license to a second set of playback license ... The specification does not disclose or suggest, that the license management device transmitting information to the provider via a third network connection and license to the playback devices via a fourth network connection. Therefore, the specification does not disclose the claimed subject matter in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Dependent claims are rejected since they are dependent of rejected claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 11 and 21 recite, “determining whether playback of digital audio content received from the content provider is authorized by comparing the first license with the digital audio content with the first set of playback devices”. It is not clear whether the first license is compared with the digital audio content or the first set of playback devices. Applicant is required to amend the claim in order to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites, “storing the first license in second digital audio content”. Claim 1, as amended recites “determining whether playback of digital audio content received from the content provider ... by comparing the first license with the digital audio content ...”. As amended, neither claim 1 or claim 2 recite a “first digital content”, which differentiate it from the second digital audio. Correction is required.

Claim 22 is rejected as stated above in claim 2.

Dependent claims are rejected since they are dependent of rejected claim.

Claim 10 recites the limitation "wherein the first digital audio content". There is insufficient antecedent basis for this limitation in the claim. Claim 1, as amended, recites a digital audio content. Correction is required.

Claim 20 is rejected as stated above in claim 10.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-18, 20-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Katz et al. U.S. Patent No. 5,926,624.

Regarding claims 1-8, 10 and 21-23, Katz teaches creating licenses having different cardinalities, indicating number of authorized playback devices; storing the license in digital audio contents; transmitting the license, via network connection, to playback devices authorizing playback of the digital audio content with the playback devices (software or hardware); wherein the digital content comprises of video digital programming. Katz teaches transmitting configuration data, which includes Group ID. Storing the Group ID in the playback devices and authorizing only the playback devices defined by the Group ID. (see col. 6 lines 5 to col. 7 line 28, col. 8 lines 5-62, col. 9 line 13 to col. 17 line 40).

Claims 11-18 and 20 are rejected as stated above in claims 1-8 and 10 respectively.

Claims 24-30 are rejected as stated above in claims 1-8 and 10 respectively.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

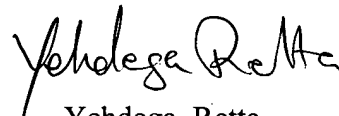
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yehdega Retta
Examiner
Art Unit 3622

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